UNITED STATES PATENT AND TRADEMARK OFFICE

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10/045,649	11/07/2001	Nobuyoshi Morimoto	5596-00901	9861

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Robert C. Kowert
Conley, Rose & Tayon, P.C.
P.O. Box 398
Austin, TX 78767

EXAMINER
RAPILLO, KRISTINE K

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3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 April 2010*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *7/14/2009* is/are: a)☒ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *2/11/2002; 6/25/2002; 1/13/2003; 1/21/2003; 8/18/2003; 12/16/2003; 2/5/2004*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the Request for Continued Examination filed April 7, 2010.

Claims 1, 19, and 20 are amended. Claims 1 - 20 are pending.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR

1.17(e), was filed in this application after final rejection. Since this application is eligible for continued

examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the

finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's

submission filed on April 7, 2010 has been entered.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1 – 2, 5, 7 – 8, 13 – 15 and 19 - 20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Harrell et al., herein after Harrell (U.S. Publication Number 2002/0156656 A1) in view

of www.pipinsure.com, herein after pipinsure

(http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html), further in view of

Welles et al., herein after Welles (U.S. Patent Number 5,686,888).

        In regard to claim 1 (Currently amended), Harrell teaches a method for arranging insurance for an

item to be shipped from an origination to a final destination, wherein the method comprises:

        Performing via one or more computers (Table 1):

receiving a request, wherein the request is a request to insure the item during shipment from the origination to the final destination (Figures 2 and 9; paragraphs [0005], [0031], [0041], and [0043]) where high risk ports (destination) are taken into consideration when requesting and generating a quote for insurance); generating a data file (Figure 1) comprising at least the following: item information including one or more characteristics of the item (paragraph [0043]) where data is input regarding the commodity (i.e. item) and Table 9 discloses various characteristics of the item, such as the type of commodity; and insurer information indicating one or more terms of said particular insurance, the insurer information specifying the insurer selected to provide said particular insurance during said shipment (Figures 2, 4, and 5; paragraph [0048]; and, Tables 3, 4, 9, and 10) where the terms could reasonably include the amount to insure the item.

Pipinsure teaches a method comprising searching a database to select particular insurance for the item, according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment (page 2 and pages 8 - 9) where the user may input information to obtain a quote of various insurance products based on criteria input by user (i.e. insured value of package, products shipped).

Welles teaches a method comprising storing the data file in a memory device (column 2, lines 62 – 67 and column 3, lines 35 – 50); a memory device that accompanies an item during said shipment (column 2, lines 62 – 67 and column 3, lines 35 – 50); accessing the memory device during or subsequent to said shipment from the origination to the final destination (column 6, lines 24 – 42); and Providing a notification to the insurer specified by the insurer information of said data file stored in the memory device in regard to damage that occurred during said shipment (column 6, lines 24 – 42).

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Harrell in view of pipinsure, further in view of Welles.

Harrell is directed to a method for selling marine cargo insurance in a network environment which includes online quoting, billing, underwriting, and claims processing.

Pipinsure is directed to a parcel insurance plan to provide lower cost package insurance to business shippers where a user may select a carrier from a list of multiple carriers.

Welles is directed to a method and system for monitoring the condition and integrity of goods in transit using electronic sensors affixed to the container being shipped.

It would have been obvious to one of ordinary skill in the art to include in the online insurance quoting system of Harrell the ability to provide lower cost shipping and insurance as taught by Pipinsure and monitoring the shipment via sensors as taught by Welles since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

In regard to claim 2 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Welles teaches a method wherein the memory device is configured to allow the data file to be updated at any time before, during or after the shipment (column 6, lines 24 – 42) where any change to the shipment is updated and tracked in real time.

The motivation to combine the teachings of Harrell, Pipinsure, and Welles is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 3 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Welles teaches a method further comprising packing the item in a container for shipping, wherein the container is configured to fit with multiple other containers in a carrier (column 6, lines 4 – 23) where Welles discloses attaching a sensor to each piece of cargo within a container.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method further comprising packing the item in a container for shipping, wherein the container is configured to fit with multiple other containers in a carrier with the motivation of monitoring the condition and/or integrity of good being shipped (abstract).

In regard to claim 5 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1. Harrell teaches a method further comprising forwarding copies of the data file via the network to one or more predetermined email addresses (paragraph [0041]).

In regard to claim 7 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1. Harrell teaches a method further comprising shipping the item using the least expensive routing (Figure 2) where Harrell discloses modifications can determine the least expensive routing (i.e. lower premiums).

In regard to claim 8 (Previously Presented), Harrell, Pipinsure, and Welles teach the method as recited in claim 1. Harrell further teaches a method wherein the data file further comprises contact information for at least one insurance companies that will provide said insurance (Figures 12 and 14) where Harrell discloses a reinsurer is notified in Figure 12, thus it is reasonable to conclude that the reinsurers contact information is available. In addition, Figure 14 illustrates contact of a claims representative and underwriter.

In regard to claim 13 (Previously Presented), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Welles teaches a method wherein the item information the data file further comprises item handling information (column 5, lines 50 – 61) where items requiring a specific temperature would require the specific temperature throughout transport, thus considered handling conditions.

The motivation to combine the teachings of Harrell, Pipinsure, and Welles is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 14 (Previously Presented), Harrell, Pipinsure, and Welles teach the method as recited in claim 1. Harrell teaches a method wherein the item information the data file further comprises item content information (paragraph [0043]) where content is equated to commodity.

In regard to claim 15 (Currently Amended), Harrell, Pipinsure, and Welles teach the method as recited in claim 1. Harrell teaches a method wherein the insurer information in the data file further comprises one or more of: an insurance carrier that provides the particular insurance, an insurance policy number that identifies the particular insurance, an amount of insurance provided by the particular insurance, and an insurance deductible for the particular insurance (paragraph [0043]) where the file contains the amount insured (i.e. insurance information).

System and storage claims 19 and 20 repeat the subject matter of claims 1, 2, and 6. As the underlying processes of claims 1, 2, and 6 have been shown to be fully disclosed by the teachings of Harrell, Pipinsure, and Welles in the above rejections of claims 1, 2, and 6; as such, these limitations (19 and 20) are rejected for the same reasons given above for claims 1, 2, and 6 and incorporated herein.

5.   Claims 4, 6, 9 – 12 and 16 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrell (U.S. Publication Number 2002/0156656 A1) in view of www.pipinsure.com, herein after pipinsure (http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html) and Welles et al., herein after Welles (U.S. Patent Number 5,686,888) as applied to claim 1 above, and further in view of Bennett et al., herein after Bennett (U.S. Patent Number 7,117,170).

In regard to claim 4 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method further comprising forwarding copies of at least a portion of the data file via the network to one or more of the parties involved in the shipping, wherein the parties include at least an originator of the request to ship the item, a recipient of the item at the final destination, and at

least one insurance company (Figures 26, 28, and 29; column 8, lines 41 – 57; column 12, lines 47 – 65; and, column 13, lines 16 - 42) where Bennett discloses origin and destination (via zip codes) and communicating this information over the internet.

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Harrell, Pipinsure, and Welles in view of Bennett.

Harrell is directed to a method for selling marine cargo insurance in a network environment which includes online quoting, billing, underwriting, and claims processing.

Pipinsure is directed to a parcel insurance plan to provide lower cost package insurance to business shippers where a user may select a carrier from a list of multiple carriers.

Welles is directed to a method and system for monitoring the condition and integrity of goods in transit using electronic sensors affixed to the container being shipped.

Bennett is directed to an apparatus system and method for electronically selecting a user's preferred method of shipping and billing by determining if the carriers meet the user's specifications.

It would have been obvious to one of ordinary skill in the art to include in the online insurance quoting system of Harrell the ability to provide lower cost shipping, insurance as taught by Pipinsure, monitoring the shipment via sensors as taught by Welles and electronically selecting the preferred method of shipping and carrier as taught by Bennett since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

In regard to claim 6 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method further comprising forwarding a copy of the data file via a network to a central server (column 8, lines 41 – 57; column 12, lines 47 – 65; and, column 13, lines 16 - 42) where a server has access to one or more databases.

The motivation to combine the teachings of Harrell, Pipinsure, Welles, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 9 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method further comprising storing the data file on a server connected to a network, wherein the server provides access to the data file via the network (column 8, lines 41 – 57; column 12, lines 47 – 65; and, column 13, lines 16 - 42).

The motivation to combine the teachings of Harrell, Pipinsure, Welles, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 10 (Previously Presented), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method wherein storing the data file comprises storing the data file in an XML format (Figures 66 and 67; column 11, lines 55 – 63; and column 55, lines 33 – 45).

The motivation to combine the teachings of Harrell, Pipinsure, Welles, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 11 (Previously presented), Harrell, Pipinsure, and Welles teach the method as recited in claim 9.

Bennett teaches a method wherein the network data is exchanged in an XML format (Figures 66 and 67; column 11, lines 55 – 63; and column 55, lines 33 – 45).

The motivation to combine the teachings of Harrell, Pipinsure, Welles, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 12 (Previously Presented), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method wherein the item information data file further comprises item weight information (Figures 29 and 39a; column 20, line 65 through column 21, line 1).

The motivation to combine the teachings of Harrell, Pipinsure, Welles, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 16 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method wherein the data file further comprises one or more digital images of the item before, during, or after shipping (column 28, line 60 through column 29, line 10).

The motivation to combine the teachings of Harrell, Pipinsure, Welles, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 17 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt (column 48, lines 43 – 57).

The motivation to combine the teachings of Harrell, Pipinsure, Keuper, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

6.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrell in view of www.pipinsure.com, herein after pipinsure (http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html) and Welles et al., herein after Welles (U.S. Patent Number 5,686,888) as applied to claim 1 above, and further in view of Kepler (U.S. Patent Number 5,347,845).

In regard to claim 18 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Kepler teaches a method wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file (column 2, lines 25 - 35).

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Harrell, Pipinsure, and Welles in view of Kepler.

online insurance quoting system of Harrell the ability to provide lower cost shipping and insurance as taught Harrell is directed to a method for selling marine cargo insurance in a network environment which includes online quoting, billing, underwriting, and claims processing.

Pipinsure is directed to a parcel insurance plan to provide lower cost package insurance to business shippers where a user may select a carrier from a list of multiple carriers.

Welles is directed to a method and system for monitoring the condition and integrity of goods in transit using electronic sensors affixed to the container being shipped.

Kepler is directed to a system for sampling air in a shipping container via a sensor.

It would have been obvious to one of ordinary skill in the art to include in the online insurance quoting system of Harrell the ability to provide lower cost shipping, insurance as taught by Pipinsure, monitoring the shipment via sensors as taught by Welles and monitoring the air via a sensor as taught by Kepler since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

7.   Applicant's arguments filed April 7, 2010 have been fully considered but they are not persuasive.

35 U.S.C. 103(a) Rejections

Claim 1

a.   The Applicant argues the cited art fails to teach or suggest i) generating a data file

comprising at least the following information including one or more characteristics of the item, and

insurer information indicating one or more terms of said particular insurance, the insurer

information specifying the insurer selected to provide said particular insurance during said

shipment and ii) storing the data file in a memory device that accompanies the item during

shipment. The Examiner respectfully disagrees.   With regard to *generating a data file,* Harrell

discloses completing data entry requirements and downloading a customer profile (Table 1 and

paragraph 126). It is suggested that downloading a customer profile will generate a data file

containing customer information. The *item information including one or more characteristics of the*

item, as claimed by the Applicant, is shown where the data is input regarding the commodity (i.e.

item); Table 9 of Harrell discloses that the information would include the type of commodity to be

shipped and characteristics (i.e. is the item to be containerized). The *insurer information*

indicating one or more terms of said particular insurance is disclosed where Harrell teaches a

system is which a quote is displayed containing quote information such as premium, deductible,

currency, terms, and conditions (Figure 2). The terms and conditions of the contract (i.e.

insurance) are provided to the user for review (paragraph 48).

        New prior art (Welles) has been applied to the limitation store the data file in the memory

device that accompanies the item during said shipment

b.   The Applicant argues the cited art fails to teach accessing the memory device during or

subsequent to said shipment from the origination to the final destination, and providing a

notification to the insurer specified by the insurer information of said data file stored in the

memory device in regard to damage that occurred during said shipment. The Examiner

respectfully submits new art has been applied to the limitations, thus Applicant's arguments are

moot.

c.   The Applicant argues that the cited art fails to teach or suggest searching a database to

select particular insurance for the item according to one or more insurance criteria, wherein the

particular insurance provides a specified level of insurance coverage during said shipment. The

Examiner respectfully disagrees. Pipinsure provides a user the ability to enter shipping needs, value of items to be shipped and coverage desired (pages 8 and 10) all of which suggest a particular insurance for shipment of an item. In addition, Pipinsure utilizes a broker for handling policy changes (page 23) suggesting the availability of different policies. In addition, the claims fail to specify that the insurer must be separate from the shipper or carrier.

d.   The Applicant argues the Pipinsure reference has not been shown to be prior art to the present application. The Applicant adds http://www.archive.org does not guarantee the accuracy of its collections, Applicant asserts that it is not proper to rely on http://www.archive.org to establish a publication date. The Examiner respectfully disagrees. The Office holds the position that a web site is considered proper prior art (see MPEP section 2128, Electronic Publications as Prior Art).

Claims 19 and 20

The Applicant argues the Examiner failed to state a prima facie rejection of claims 19 and 20 because the office action failed to address specific limitations of claims 19 and 20. The Examiner respectfully disagrees and submits Pipinsure provides a data field in which a user may input the highest insured value of any package when requesting a quote for package insurance (page 8), thus the highest insured value is equated to a maximum coverage. Therefore, Applicant's argument is not persuasive.

Conclusion

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 3:30 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Morgan can be reached on 571-272-6773. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. K. R./
Examiner, Art Unit 3626

/C. Luke Gilligan/
Primary Examiner, Art Unit 3626